

REMARKS

I. INTRODUCTION

In accordance with the restriction requirement proposed by the Examiner, Applicant elects Claims 13-20 with out traverse. Pursuant to the Office Action mailed May 6, 2003 (hereinafter "Office Action"), Applicant understands that claims 1-12 have been withdrawn from further consideration by the Examiner as being drawn to a non-elected invention. Accordingly, Claims 1-12 are listed in the claim listings as "withdrawn".

With respect to Claim 16, Applicant previously presented a preliminary amendment filed on April 25, 2002, amending Claim 16. Accordingly, the preliminary amendment filed on April 25, 2002, has been incorporated in Claim 16 in the claim listings as "previously presented". Applicant respectfully requests that the Examiner confirm receipt of the preliminary amendment.

With respect to Claims 13 and 15, Applicant currently amends Claims 13 and 15 to better reflect the invention.

The amended claims are supported by the original specification and include no new matter.

Accordingly, Claims 13-20 are presently pending in this application. Applicant respectfully requests further examination and reconsideration of the application in view of the foregoing amendments and the following arguments.

II. REJECTION OF CLAIM 17 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

1. Claim 17 stands rejected under 35 U.S.C. § 112, second paragraph. The examiner has asserted that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention.

Applicant respectfully traverses the rejection of Claim 17 under 35 U.S.C. § 112, second paragraph. Applicant respectfully submits that the language "capable of" followed by "interconnection with an aperture in a portion of a mating structure and having suitable rigidity to retain the primary extrusion relative to the structure" represents

functional claim language having the requisite degree of specificity to convey to one of ordinary skill in the art the scope of the invention, as defined by a particular capability, in accordance with, among other things, MPEP 2173.05(g) and policy established by the Office of Deputy Commissioner for Patent Examination Policy:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient or step of a process to *define a particular capability* or purpose that is served by the recited element, ingredient or step. See, for example, In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) (*emphasis added*) wherein the Court held that in a claim directed to a kit of component parts capable of being assembled, limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

See MPEP 2173.05(g), See Office of Deputy Commissioner for Patent Examination Policy at: <http://www.uspto.gov/web/offices/pac/dapp/35usc112.htm#purpose>

Applicant's claim language is further supported in the Specification and Figures.

Figure 1 illustrates an embodiment of an exemplary polymeric component 1 formed into a polymeric door seal having a primary extrusion 10 formed into the shape of an elongated seal and section molded portion 20 formed into the shape of a barbed snap. . . .

. . . .

. . . . As shown in Figure 1, the section molded feature 20 is capable of interconnection with an aperture 52 in the mating structure 50 and has sufficient rigidity to retain the primary extrusion 10 relative to the mating structure.

Specification, Paragraphs 0015-0016

Applicant respectfully submits that the rejection under 35 U.S.C. § 112, second paragraph, has been overcome. Accordingly, Applicant requests withdrawal of the rejection and allowance of Claim 17.

III. REJECTION OF CLAIMS 13-20 UNDER 35 U.S.C. § 102(b)

2. Claims 13-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Number 5641379 entitled Apparatus For Producing A Thermoplastic Article Having An Undercut Cross-Section by *Cesano*. (hereinafter “*Cesano*”)

Applicant respectfully traverses the rejection under 35 U.S.C. § 102(b) and respectfully submits that the rejection of Claims 13-20 under 35 U.S.C. § 102(b) is improper because *Cesano* does not disclose or suggest all of the limitations recited in the claims. In re Paulsen, 30 F.3d 1475, 1478-79, 31 U.S.P.Q.2d 1671 (Fed. Cir. 1994); Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1997) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”).

With respect to amended independent Claim 13, Applicant respectfully submits that *Cesano* does not disclose or suggest the recited limitations of amended independent Claim 13. *Cesano* merely discloses a “sheet” 12, and a separate “aesthetic covering” 14. **[*Cesano*, Figure 3, Number 14]** In contrast, Applicant’s invention provides for a “primary extrusion” and a “section molded portion integral with the primary extrusion”. Further, Claim 13 has been amended to provide that the “section molded portion” “takes the form of a projection having a cross section with variable dimensions including a first portion extending from the primary extrusion and having a first outer dimension, and a second portion extending from the first portion and having a second outer dimension that

is greater than the first outer dimension of the projection.” [See e.g., Specification, Paragraph 0034] [See e.g. Figures 12A-C (elements 52 and 53)] [See e.g., Specification, Paragraph 0036] [See e.g., Figure 14 (element 20)] [See e.g., Paragraph 0037] [See e.g., Figure 15a-C (element 20)] Because, *Cesano* fails to teach or suggest all of the limitations recited in amended independent Claim 13, Applicant submits that the rejection of Claim 13 under 35 U.S.C. § 102(b) is improper and requests that the rejection be withdrawn.

With respect to amended dependant Claim 15, the Office Action fails to identify any portion of *Cesano* relating to a section molded feature having a corrugated inner shape and a corrugated outer shape.

Further, because each of Claims 14-16 depend from Claim 13, Applicant submits that the rejection of dependant Claims 14-16 under 35 U.S.C. § 102(b) is also improper.

Because, *Cesano* fails to teach or suggest all of the limitations recited in Claims 13-16, Applicant submits that the rejection of Claims 13-16 under 35 U.S.C. § 102(b) is improper and requests that the rejection be withdrawn.

With respect to independent Claim 17, Applicant respectfully submits that *Cesano* does not disclose or suggest the recited limitations of Claim 17. Claim 17 includes: a primary extrusion of co-extruded material wherein the primary extrusion includes at least one thermoplastic material, and at least one section molded portion formed in the portion of the primary extrusion formed from thermoplastic material and extending from the primary extrusion and integral with the primary extrusion, the section molded portion is capable of interconnection with an aperture in a portion of a mating structure and having suitable rigidity to retain the primary extrusion relative to the structure.

Among other things, Applicant’s invention provides for a “primary extrusion” and a “section molded portion integral with the primary extrusion”. In contrast, *Cesano* discloses a “sheet” 12, and a separate “aesthetic covering” 14. [***Cesano*, Figure 3, Number 14**] Contrary to the assertion in the Office Action, *Cesano* does not disclose a section molded portion “capable of interconnection with an aperture in a portion of a mating structure and having suitable rigidity to retain the primary extrusion relative to the structure.” The Office Action merely refers to working surface 18 [***Cesano*, Figure 3,**

Number 18] of a first molding element used to form “arcuate –profile portion 8 of handle 4” [*Cesano*, Column 2, Lines 23-26]. Working surface 18 is not part of the produced product of *Cesano*. Further, the Office Action does not identify an portion of the “aesthetic covering 14” in *Cesano* that is suitable for interconnection with an aperture in a portion of a mating structure and having suitable rigidity to retain the primary extrusion relative to the structure.

With respect to dependant Claim 18, which includes among other things a “section molded portion being in the shape of a barbed projection having a thin walled portion having a first outer diameter and extending from the primary extrusion and a thick walled portion having a second outer diameter greater than the first outer diameter.” The Office Action fails to identify a “section molded portion in the shape of a barbed projection.” Instead, the Office Action merely refers to an “aesthetic covering” [*Cesano*, **Figure 4, Number 14**] and to “fixing members 28”. [*Cesano* **Figure 4, Number 28**] applicant respectfully submits that no portion of the “aesthetic covering 14 of *Cesano* includes a barbed projection. Further, the “fixing members 28” of *Cesano*, appear to be portions of a “second moulding element 24” and not part of the produced product, the handle 4 [*Cesano*, Column 2, Line 11]

With respect to dependant Claim 20, Applicant respectfully repeats its statements with respect to independent Claim 17. Further, among other things, Claim 20 provides for the combination of a primary extrusion being formed from a C-shaped cross section and a section molded portion being in the shape of a barbed projection. The Office Action fails to identify this combination.

Further, because each of Claims 18-20 depend from Claim 17, Applicant submits that the rejection of dependant Claims 18-20 under 35 U.S.C. § 102(b) is also improper.

Because, *Cesano* fails to teach or suggest all of the limitations recited in Claims 17-20, Applicant submits that the rejection of Claims 17-20 under 35 U.S.C. § 102(b) is improper and requests that the rejection be withdrawn.

Applicant respectfully submits that the rejection of Claims 13-20 under 35 U.S.C. § 102(b) as being anticipated by *Cesano* has been overcome. Accordingly, Applicant requests withdrawal of the rejection and allowance of Claims 13-20.

IV. CONCLUSION

For the above cited reasons, the drawings, specification, and all of the claims presently pending in this application are believed to be allowable. Accordingly, Applicant respectfully requests allowance of the application. If the Examiner has any further questions or concerns, the Examiner is invited to contact the Applicant's undersigned attorney.

Respectfully submitted,

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